Application No. 09/963,914
Amendment "B" dated June   , 2005
Reply to Office Action mailed June 3, 2005

REMARKS

The final Office Action, mailed June 3, 2005, considered and rejected claims 1-4, 7-9, 11, 14, 16, 18, 21 and 22. Claims 11 and 21 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 2-4 and 7 are rejected under 35 U.S. C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as invention. Claims 1-3, 8, 14, and 18 were rejected under 35 U.S.C. 103(a) as unpatentable over Gao (U.S. Publication No. 2002/0032701) in view of Homer, et al. ("Instant HTML") and JS-Examples ("Image Sized Popup") and Shiran ("Scriplet Authoring"). Claims 4, 9, 16, and 21-22 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Gao (U.S. Publication No. 2002/0032701) in view of Homer, et al. ("Instant HTML"), JS-Examples ("Image Sized Popup") and Shiran ("Scriplet Authoring") as applied to claims 1 and 8 above and further in view of Hunt (U.S. Publication No. 2004/0133848).[1]

By this paper, claims 1, 2-4, 7, 11 and 21 have been amended, claims 24 and 25 have been added and claims 14 and 22 have been cancelled, such that claims 1-4, 7-9, 11, 16, 18, 21 and 23-24 remain pending, of which claims 1, 11 and 21 are the only remaining independent claims at issue.

Many of the claim amendments have been made to fix minor informalities and to overcome the corresponding rejections of record. For example, claims 2-4 and 7 were amended to fix problems related to antecedent basis. Claims 14 and 22 have also been cancelled and incorporated into claims 11 and 21, to clarify that the computer-program product claims comprise physical media, thereby overcoming the 101 rejections.

Now, with regard to the independent claims, it will be noted that claim 1 is directed to a method and claims 11 and 21 are directed to computer program products having computer-executable instructions for implementing the method recited in claim 1 as well as a similar method recited in dependent claim 16.

---

[1] Although the prior art status of the cited art is not being challenged at this time, and some of the assertions of the cited art is not being specifically addressed, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art at any appropriate time in the future, should the need arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any assertion made with regard to the prior art, including the asserted prior art status.

Application No. 09/963,914
Amendment "B" dated June   , 2005
Reply to Office Action mailed June 3, 2005

As indicated in the claims listing, the claims are generally directed to embodiments for overlaying content over a displayable form of a document in response to a detected event. In some embodiments, for example, this can include overlaying content over a browser displayed document in response to cursor movements to particular regions of a screen. The regions of the screen be various regions, including regions other than text elements (new claim 25), and regions such as fields other than text elements (new claim 24).

As further described in some of the claim embodiments, the client also retrieves the event-based content to overlay the document at the same time it retrieves the computer-executable instructions, which will then be displayed on the screen when the cursor moves to a defined region on the screen.

As further clarified by the claim amendments, the content is displayed when the cursor moves to a particular region on the screen and in such a way that the content is displayed even when the document is using frames, a drop-down list, ActiveX controls or custom controls. This provides a particular advantage over the prior art.

For at least these reasons, Applicants respectfully submit that the pending claims are neither anticipated by nor made obvious by the art of record, either singly or in combination[2]. In particular, the art fails to disclose or suggest, among other things, that the content is downloaded when the computer-executable instructions are downloaded, and particularly when the content is displayed overlaying a displayed document, even when the document is using frames, a drop-down list, ActiveX controls or custom controls[3].

The forgoing clarification made by the present claim amendments are particularly relevant when considering how Applicants described in their background that existing systems and methods do not enable such functionality, because such functionality is preempted by other

---

[2] To establish a prima facie case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143 (emphasis added). Further, "[i]n determining the difference between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP § 2141.02. In light of these requirements, the prior art must illustrate specifically each limitation without improper combinations to show elements that simply do not exist in the cited references. In other words, it is improper to reject the claims as obvious by stating what one of skill in the art might have done without specifically citing where such an element is disclosed. Obviousness may not be based on impermissible hindsight, using "knowledge gleaned only from applicant's disclosure." MPEP § 2145(X)(A).

[3] Support for these claim amendments include the disclosure found in paragraphs 15-16 and 56.

processes such as frames, drop-down lists boxes, ActiveX controls, custom controls and so forth. (see paragraph 8, for example).

Applicants also respectfully submit that the cited art fails to disclose or suggest a method as recited, including detection of movement of a cursor to a particular region of the screen, particularly a region other than text, such as a field[4], and as recited in claims 24 and 25. With regard to such embodiments, the Examiner has suggested that Gao teaches detecting a mouse pointing to a designated text element. It will be appreciated, however, that claims 24 and 25 are clearly distinguished from such a teaching, even assuming, *arguendo*, that Gao makes such a teaching. In particular, it will be appreciated that a region is distinguished from a text element, particularly when the region is specifically distinguished as being other than a text element.

Furthermore, with regard to dependent claim 18, Applicants also respectfully submit that although Homer discloses a mouse over prompt, there is no disclosure to suggest or motivate the detection of the cursor to a region other than a text element, even when combining Gao and Homer.

Finally, with regard to the claim element that the content is displayed overlapping a document, and in such a way that the content is displayed even when the document is using frames, a drop-down list, ActiveX controls or custom controls, Applicants respectfully submit that the cited art fails to disclose or suggest such an embodiment. The cited disclosure also fails to disclose or suggest that the new content is displayed in an ActiveX window, as recited in new claim 23.

The Examiner has suggested that Hunt discloses "a popup window may be closed automatically or it may require the user to explicitly close it." Applicants respectfully submit, however, that this is not what is required by the newly amended claims. In particular, the newly amended claims require that the content is displayed in a new window that overlays the displayed document. Accordingly, whether a window can be closed or not is irrelevant, inasmuch as the claims require the content to overlay the document in a new window, something that is neither anticipated by nor made obvious by the art of record, either alone or in combination. (see amended claim 1 and also dependent claim 4).

---

[4] Support for these claim amendments include the disclosure found in paragraph 42 and Figure 3.

Application No. 09/963,914
Amendment "B" dated June   , 2005
Reply to Office Action mailed June 3, 2005

         Accordingly, for at least the foregoing reasons, Applicants respectfully submit that the pending claims are now in condition for prompt allowance over the art of record.

         Although the foregoing remarks have been focused primarily on the independent claims, Applicants note for the record that all of the rejections and assertions of record with respect to the independent and dependent claims are now moot, for at least the foregoing reasons, and therefore need not be addressed individually[5].

         In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

         Dated this   **7**   day of July, 2005.

                                Respectfully submitted,

                                RICK D. NYDEGGER
                                Registration No. 28,651
                                JENS C. JENKINS
                                Registration No. 44,803
                                Attorneys for Applicant

                                Customer No. 47973

RDN:JCJ:ppa
W:\13768\203\PPA0000000367V001.DOC

---

[5] It will be appreciated, however, that Applicants do not necessarily acquiesce to any assertions in the Office Action that are not specifically addressed above, and hereby reserve the right to challenge those assertions in the future, including any official notice taken by the Examiner, if necessary or desired.